

Application No. 10/662,683

Docket No.: 28076/SV1094

REMARKS

Claims 11-19 were examined in the most recent office action, dated June 7, 2005. Claims 1-10 and 20-32 were withdrawn by the examiner as being drawn to a non-elected group. These claims have been canceled herein. All of claims 11-19 stand rejected as obvious.

Claim 11 is Allowable.

Applicants traverse the rejection to claim 10 under 35 U.S.C. § 103(a) as being obvious over Sunuaga, et al., U.S. Patent No. 6,737,770 ("Sunuaga"). Claim 11 recites, in part, severing the first magnet wire between the input terminal and the exit terminal on the fuse. The office action acknowledges that Sunuaga fails to disclose this element, but argues that it would be a "mere matter of design choice to have a magnet wire shunt across the input terminal and the exit terminal on the fuse and severing that shunt to make the fuse functionable." Office action, page 4.

The only vehicle by which the office may find a claim obvious without citing any reference that discloses a particular limitation of that claim is through official notice or the assertion of common knowledge. "In limited circumstances, it is appropriate for an examiner to take official notice of facts not in the record or to rely on "common knowledge" in making a rejection, however such rejections should be judiciously applied." MPEP § 2144.03. It is "not appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." MPEP § 2144.03(A) (emphasis in original). There must be some form of evidence in the record to support an assertion of common knowledge. MPEP § 2144.03(B). General conclusions concerning what is basic knowledge or common sense to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection. *Id.* (citing *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2002)).

Here, the office has not properly taken official notice. The office action makes no finding that the noted claim limitation is capable of instant and unquestionable demonstration as being well-known. There is also no evidence in the record to support an assertion of common

Application No. 10/662,683

Docket No.: 28076/SV1094

knowledge. There have been no specific factual findings and there is no concrete evidence in the record to support any factual findings. Because this response adequately traverses the office action as not properly based on common knowledge, the next office action must support the finding with adequate evidence. MPEP § 2144.04(C).

In any event, the claimed invention is not suggested by the cited reference. As outlined in paragraphs 2 and 3 of the specification, in prior electric motors, the magnet wire is terminated at the fuse, and a separate lead wire is connected to the fuse and the power switch. This method is inefficient, because "two separate wires are necessary, and thus separate steps are required in the manufacture of the electric motor." The claimed feature addresses this inefficiency. Sunuaga fails to teach or suggest the noted claim limitation. Lewchenko, U.S. Patent No. 6,058,595, cited against certain dependent claims, adds nothing.

It is respectfully submitted that the office action is based on improper hindsight reasoning. Because there is no reference that teaches the claimed feature, the only method of arriving at the claimed feature is by using this application as a guide. The office action's opinion that a connection using a circuit board is known and this connection "would perform equally well or better" is of no significance. The proper question is whether the claimed features are disclosed or suggested by the prior art, not whether an unrelated system would perform better.

Because the office action has not properly made a *prima facie* case of obviousness, and there is no teaching in the record of the noted claim feature, the rejection to claim 11 must be withdrawn. Claim 11 is therefore allowable. Dependent claims 12-19 are also allowable for the same reasons. Allowance of all claims is respectfully requested.

In particular, the rejection to claim 12 is improper. Claim 12 recites routing the first magnet wire along the winding board under clips. The office action asserts that Sunuaga teaches routing the magnetic coil through a printed circuit board, "which is obvious to be more efficient than clipping an exposed wire for routing." Again, the office's determination that a printed circuit board would be more efficient than the claimed method is legally irrelevant. No cited reference discloses or suggests the claimed elements. Accordingly, claim 12 is allowable over the references cited in the office action.

Application No. 10/662,683

Docket No.: 28076/SV1094

CONCLUSION

In view of this amendment, applicant believes the pending application is in condition for allowance. If, in the opinion of the examiner, a telephone conference would expedite prosecution of the subject application, the examiner is invited to call the undersigned attorney.

No fee is believed due at this time. However, if any fee is due, please charge our Deposit Account No. 13-2855, under Order No. 28076/SV1094 from which the undersigned is authorized to draw.

Dated: September 7, 2005

Respectfully submitted,

By 

Russell C. Petersen

Registration No.: 53,457

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicant